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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09-726,507	12-01-2000	Akinori Harada	Q61904	1096

7590 07/02/2003
SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3213

EXAMINER

HAMILTON, CYNTHIA

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/726,507

Applicant(s)

HARADA ET AL.

Examiner

Cynthia Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 04 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 and 10-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 14-16 is/are allowed.
- 6) ☐ Claim(s) 7-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 1-16 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

2. A person shall be entitled to a patent unless –

3. (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim 7 is rejected under 35 U.S.C. 102(e) as being anticipated by Liu et al (US 2002/0074320 A1). The apparatus of claim 8 of Liu et al anticipates the apparatus of instant claim 7 wherein the means for setting pulse energy in Liu et al is the modulator of the instant application

5. Applicant's arguments filed April 4, 2003 have been fully considered but they are not persuasive. Applicants argue that since they claimed the benefit of their priority document, then Liu et al which is a latter date should be removed as prior art. Applicants cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15. It is required that any translation of the priority document filed for this purpose must also have a statement that the translation of the certified copy is accurate. Applicant's translation does not have such a statement. The Declaration attached to the translation given by applicants says "THAT the attached is a full, true, accurate and faithful translation into the English language made by me of Japanese Test of the U.S. Serial No. 09/507." Thus, applicants have failed to meet the requirements of 37 CFR 1.55 (a)(4), i.e. "(4) An English language translation of a non-English language foreign application is not required except when the application is involved in an

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interference (§ 1.630), when necessary to overcome the date of a reference relied upon by the examiner, or when specifically required by the examiner. If an English language translation is required, it must be filed together with a statement that the translation of the certified copy is accurate." The rejection stands.

6. Claims 14-16 are allowed. Liu et al make no comment about printing or photosensitive plate making material being used with their ultra-fast pulse laser.

7. Claims 7-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Aitken et al (6,573,026 B1) as evidenced by "modulate" (yourdictionary.com). The pulsed laser with translation device and amplifier of Aitken et al anticipates the instant apparatus wherein the amplifier is a modulator if modulate means to change the amplitude as defined in yourdictionary.com. In Aitken et al, see particularly paragraph bridging col. 1-2 and col. 2, paragraph bridging col. 3-4 and col. 6, lines 42 to col. 7, lines 18 and Examples.

8. Because Aitken et al is newly cited and applicants did not amend claim 7 to overcome art rejections, this action is not made final.

9. Applicant's election without traverse of Group II, claims 7-9 in Paper No. 5, filed June 26, 2002 is acknowledged.

10. Claims 1-6, 10-13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in Paper No. 5.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner Cynthia Hamilton whose telephone number is (703) 308-3626. The examiner can normally be reached on Monday-Friday, 9:30 am to 5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on (703) 308-2303. The fax phone numbers for the organization

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where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application should be directed to the 1700 receptionist whose telephone number is (703) 308-0661.

Cynthia Hamilton
June 30, 2003


CYNTHIA HAMILTON
PRIMARY EXAMINER